

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

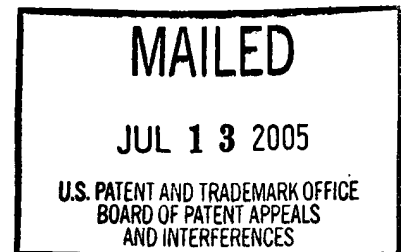
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte QUINTON YVES ZONDERVAN

Appeal No. 2005-0612
Application No. 09/481,512

HEARD: May 18, 2005



Before JERRY SMITH, BLANKENSHIP, and SAADAT, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 9, 12, 14, and 21-47, which are all the claims remaining in the application.

We affirm-in-part.

BACKGROUND

The invention relates to an integrated messages system for a user having access to accounts on a number of different terminal communication devices, whereby the messages may be changed in format. Claim 9 is reproduced below.

9. A method for managing communications of electronic messages between a first terminal device and a second terminal device, wherein the first terminal device has a first message presentation format and the second terminal device has a second message presentation format, the method comprising:

receiving an electronic message from the first terminal device, said electronic message in the first message presentation format;

modifying a presentation format of the electronic message from the first message presentation format to a modified message presentation format; and

sending the electronic message in the modified message presentation format to the second terminal device,

wherein the modified message presentation format is other than the first message presentation format.

The examiner relies on the following references:

Pepe et al. (Pepe)	5,742,905	Apr. 21, 1998 (filed Sep. 19, 1994)
Cleron et al. (Cleron)	6,223,213 B1	Apr. 24, 2001 (filed Jul. 31, 1998)

Claims 9, 12, 14, and 21-46 stand rejected under 35 U.S.C. § 102 as being anticipated by Pepe.

Claim 47 stands rejected under 35 U.S.C. § 103 as being unpatentable over Pepe and Cleron.

An earlier rejection of claims 9, 12, 46, and 47 under 35 U.S.C. § 112, second paragraph has been withdrawn by the examiner.

We refer to the Rejection (Paper No. 12) and the Examiner's Answer (Paper No. 19) for a statement of the examiner's position and to the Brief (Paper No. 16) for appellant's position with respect to the claims which stand rejected.

OPINION

Pepe discloses a communications network including a "Personal Communications Internetworking" (PCI) device 40 that performs media conversion between different mobile and office devices (Fig. 1). As described at column 5, line 27 et seq., a subscriber may select the media format and serving network used to receive messages. PCI 40 will accordingly perform a media conversion to allow, for example, an e-mail message to be delivered to a fax server. Figures 33 through 36, and columns 34 and 35, provide further detail with respect to how a user may select a destination for incoming messages whereby, as a further example, a text message may be converted to synthesized speech and received in a voice mailbox.

Appellant argues (Brief at 6), in defense of claim 9, that Pepe may disclose modifying the "delivery" format of an electronic message from one type of device to another type of device, but the reference does not disclose modifying a "presentation"

format of the message and sending or transmitting the electronic message in the modified presentation format.

We agree with the examiner that the language of claim 9 fails to distinguish over the method disclosed by Pepe. The claim does not specify details of the “presentation” format, nor what the basis of the “presentation” may be. We see no substantive reason why changing the format of, for example, a message formatted for presentation to an electronic mail reception device to a format suitable for presentation to a facsimile device cannot fairly be considered as modification of a “presentation” format. Appellant does not point to any clear definition in the specification requiring the asserted narrow reading of the language. Cf. In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (repeating the principle that where an inventor chooses to be his own lexicographer and gives terms uncommon meanings, he must set out the uncommon definition in the patent disclosure). See also Beachcombers Int'l, Inc. v. WildeWood Creative Prods., Inc., 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994) (“As we have repeatedly said, a patentee can be his own lexicographer provided the patentee’s definition, to the extent it differs from the conventional definition, is clearly set forth in the specification.”).

Appellant submits (Brief at 6) that modifying a delivery format is “entirely different” from modifying a message presentation format, with the reasoning that “these occur at different layers in the communication channel.” The argument is not

commensurate with the scope of claim 9; the claim is silent with respect to layers in a communication channel. We are also unpersuaded by appellant's argument (id.) that Pepe does not disclose that the modified message presentation format is other than the first message presentation format, because we disagree that Pepe fails to disclose modifying the "presentation" format within the meaning of the claim.

We therefore sustain the rejection of claims 9, 12, 14, and 41, as claims 12, 14, and 41 fall with claim 9.

Appellant's arguments in the Brief, although under separate headings, do not support appellant's nominal groupings of the claims with respect to independent claims 21 and 37, and dependent claims 22, 26, and 30-33. See 37 CFR § 1.192(c)(7) (2003) ("Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable."); 37 CFR § 41.37(c)(1)(vii) (Sep. 13, 2004) ("A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim."). See also In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) ("If the brief fails to meet either requirement [of 37 CFR § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim."). Appellant's arguments in support of patentability for independent claims 21 and 37, and dependent claims 22, 26, and 30-33 are founded

on the same assertion we have addressed with respect to claim 9, and we sustain the rejection of those claims. We are unpersuaded that the “presentation” format of the claims distinguishes over what appellant calls the “display” format of Pepe. In any event, appellant does not show error in the examiner’s findings set out in the Answer. To the extent appellant’s comments might be considered as supportive of the nominal groupings, we refer to the examiner’s findings rather than repeating them herein.

Appellant argues (Brief at 10-11) that claims 27 and 42 require that the modified presentation format corresponds to a type of terminal device other than the first and the second terminal device. The specific requirements of claims 27 and 42 are not addressed in the statement of the rejection (see, e.g., Answer at 6 and 7). Nor do we find responsive arguments from the examiner in the Answer as to how Pepe may be deemed to anticipate the subject matter. We find no disclosure in Pepe within the claimed requirements, and do not sustain the rejection of claims 27 and 42.

Claim 23 is similar to claim 27, but broader in reciting that the modified message presentation format is “other than said second message presentation format.” We note that base claim 21 does not require that the second terminal device transmits and receives electronic messages only in one (a second) message presentation format. However, neither the statement of the rejection nor the examiner’s responsive arguments (Answer at 10) identifies a “terminal device” that may receive an electronic message in a message presentation format different from that which it uses for

transmitting and receiving electronic messages. We therefore cannot sustain the rejection of claim 23, nor claim 24 reciting the same limitation.

We have considered appellant's arguments in support of claims 28 and 43 through 45 (Brief at 11-12). However, we agree with the examiner that the media conversion taught by Pepe is sufficient to meet the claim 28 requirement that the message "appears" to have been sent from a different type of terminal device from that which originated the message. We sustain the rejection of claims 28 and 43 through 45.

We find appellant's arguments in support of claims 25 and 38 (Brief at 9-10) and claims 29 and 39 (id. at 13) to implicitly rely on the argument that the claimed "presentation" format cannot refer to what appellant submits to be the "delivery" format described by Pepe. Because we find that a user specifying delivery and origination options of electronic messages (e.g., Pepe at col. 6, ll. 34-42) specifies the "modified message presentation format" when a message requires media conversion, we sustain the rejection of claims 25, 29, 38, and 39.

Appellant argues (Brief at 14) that Pepe fails to disclose the subject matter of claim 34, wherein the scripting agent "modifies the presentation format of the electronic message to said second terminal device by adding at least one of a signature block, a header, and a footer." The "scripting agent," according to claim 32, is that which modifies the presentation format. Pepe at column 25, line 51 through column 26, line

10, and column 26, lines 36 through 65, describes delivering messages to different networks by use of mail protocols such as those appropriate for the Internet. We find claim 34 to be anticipated by Pepe because the claim requires no more than, in one alternative, the addition of an e-mail header as required when using mail servers in disparate networks, for proper routing and presentation to the destination device (e.g., PDA or fax machine).

Instant claim 35 recites that the modified presentation format received is the same as a presentation format of an electronic message sent by the second terminal device and received by the first terminal device (i.e., the device from which the message that was modified originated). The requirements are similar, in effect, to those of claims 23, 27 and 42. We cannot sustain the rejection of claim 35 (and depending claim 36) because, as we have noted, there has been no showing that Pepe discloses a "terminal device" that may receive an electronic message in a message presentation format different from that which it uses for transmitting and receiving electronic messages.

For reasons similar to those underlying our conclusion with respect to claims 23, 27, 35, and 42, we cannot sustain the rejection of claim 40. The claim requires that the modified message presentation format is other than the message presentation format used by the receiving terminal device.

Appellant also argues (Brief at 17-18) that claim 46 (and depending claim 47) requires modification of a presentation format and modification of a delivery format, and transmission of the message in the modified message presentation format and in the modified delivery format. Appellant submits that “[t]o the extent that claim 46 requires modification of both the delivery format and the presentation format of the message, the Examiner can no longer rely on the former to disclose the latter.” (Brief at 18.)

We do not consider it a requirement, however, that broad language be limited to a single narrow interpretation, especially when used in claims setting forth different combinations and differing substantially in scope. See In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“[D]uring patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.”).

Pepe at column 26, lines 14 through 23 describes translating an e-mail message into a paging message, which may be regarded as modification of a “delivery format” of the electronic message. The reference section reports that the PCI server also formats the paging message such that it may be changed with respect to the number of pages and the number of characters per page. As such, the translation may be fairly considered a modification of the “delivery format,” and the page formatting may be fairly considered a modification of the “presentation format” – i.e., changing the appearance

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of the message in addition to modifying the protocols for delivery as needed for transferring a message from an e-mail to a paging network.

We thus sustain the § 102 rejection of claim 46, and the § 103 rejection of depending claim 47, which appellant has not shown to be in error.

CONCLUSION

We sustain the rejection of claims 9, 12, 14, 21, 22, 25, 26, 28-34, 37, 38, 39, 41, and 43-47. We do not sustain the rejection of claims 23, 24, 27, 35, 36, 40, and 42. The examiner's decision to reject claims 9, 12, 14, and 21-47 is thus affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Howard B. Blankenship

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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